

## REMARKS

This is a reissue application based on U.S. Patent No. 5,905,865, filed on 30 April 1996 and granted on 18 May 1999. This is also a divisional of reissue application serial no. 09/860,259, filed on 18 May 2001, within the two-year interval specified by 35 U.S.C. § 251 for the filing of broadening reissues.

### I. Amendments to the claims

All of pending claims 39-48 are amended. The amended claims retain the characteristics of the originally-presented claims, which find support in the original disclosure as indicated previously. The limitations have been rearranged to improve the structure of the claims, and the claims adopt more general phrasing consistent with the provisional application to which the patent claims priority, serial no. 60/008,111.

References to "audio or video programming" are supported, *e.g.*, in the provisional application (which by incorporation is also a part of the patent as filed) at page 1, first paragraph. References to transmitting addresses "substantially simultaneously" with audio or video programming are supported, *e.g.*, at page 3, lines 8-13, of the provisional application. The independent claims have been further amended to require that the connection between users' computers and the website be established automatically and without interaction by the users, as supported, *e.g.*, in the issued claims of the '865 patent.

The amendments add no new matter to the disclosure.

### II. Related Applications

Applicant notes for the record of this application that prosecution continues in the parent of this reissue application, reissue application serial no. 09/860,259. A final Office action setting forth various grounds of rejection was mailed on 13 November 2008, and applicant filed a request for continued examination (RCE) in response on 14 September 2009.

Applicant also notes for the record that four other divisional reissues were filed based on the parent reissue application. The serial numbers of those applications are

10/668,098; 10/668,096; 10/668,099; and 10/668,101. All of those applications were assigned to the examiner who then had responsibility for this reissue application, and in each application, a first Office action was mailed in April, 2006. Applicant chose not to respond to those actions, and each of the '096, '098, '099, and '101 applications is now abandoned.

### **III. Reissue declaration**

The examiner objected to the reissue declaration because the specified error is said to involve the recapture of subject matter surrendered during the prosecution of the patent, and thus does not constitute a proper reissue error. Office action ¶¶ 6.

For the reasons set forth immediately below, applicant traverses the examiner's conclusion that the claims seek to recapture surrendered subject matter. Thus, applicant believes that the reissue declaration specifies an error that establishes a proper basis for the reissue proceeding. Reconsideration and withdrawal of the objection are requested.

### **IV. Rejection under 35 U.S.C. § 251**

Claims 42-48 were rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Office action ¶¶ 9-16. The basis for the rejections relates to the omission of limitations involving "receiving an address at an address transmitter," "transmitting to occur simultaneously," "automatically accessing," and "independent of user interaction."

Applicant traverses the rejections. All of the claims have been amended to incorporate language that imposes requirements corresponding to "transmitting to occur simultaneously," "automatically accessing," and "independent of user interaction." Thus, applicant believes that the rejections are moot in respect of those limitations.

The rejection relating to "receiving an address at an address transmitter" relates to language added to the original claims in response to a rejection under § 112, second paragraph.

The essential predicate of a recapture rejection is a concession of claim scope that occurred following the imposition of a rejection over prior art. Recapture has been limited by the courts to situations where a patent applicant, facing a rejection of the claims over prior art for patentability, has narrowed the claims to overcome the prior art rejection. Under the recapture doctrine, that applicant may not then broaden the claims through reissue to encompass subject matter conceded during the original prosecution to be unpatentable in view of the prior art.

In the present case, the rejections in the original prosecution that the Office has identified as the basis of its recapture theory, and amendments made in response to those rejections, were of a different character. In the prosecution of the '865 patent, the examiner simply asserted that it was unclear what the claims covered. Amendments that may give rise to recapture issues (*i.e.*, narrowing amendments made in response to prior art rejections) are distinct from amendments that clarify the metes and bounds of claims in response to a rejection based on a lack of clarity.

The present claims do not suffer the same alleged defect under § 112, second paragraph, that gave rise to the relevant rejections during the original prosecution. Accordingly, the claims do not "recapture" the supposed lack of clarity that the applicant "surrendered" through responsive amendments.

For at least the reasons give above, none of the pending claims violates the recapture doctrine with regard to "receiving an address at an address transmitter."

Applicant requests that the examiner reconsider and withdraw all of the outstanding grounds of rejection under § 251.

**V. Rejection under 35 U.S.C. § 112, first paragraph**

Claims 46-48 were rejected under § 112, first paragraph, as claiming subject matter that was not described in the original application. Office action ¶ 19.

The method of claim 46 does in fact find support in the disclosure as filed. The '111 provisional application, which forms a part of the original specification, describes profiling applications at page 5:

15. Demographic Data Collection – With permission of the user, where applicable, detailed profile form information can be collected and summarized for the benefit of content providers. For example, how many people requested a class of information such as ALL automobile Mini-Van advertisers.

16. Grass Roots Activism – Organizations that issue "Call to Action" type messages or content can immediately reach users who have shown an interest based on the user profile form and/or the user's specific request for more information on the organization's needs and activities. (software ability to add a user to an electronic mail mailing list.)

The examples set forth at pages 4-5 of the '111 provisional application are all provided with reference to an exemplary system which automatically connects a user's computer to a website in response to a broadcast URL. See page 3, "An example of how the system works." As examples 15 and 16 demonstrate, the collection of data based on specific user responses for creating profiles is expressly contemplated.

Because the methods of claims 46-48 are fully described in the application as filed, the subject matter of the claims is supported as required under § 112. Applicant requests that the examiner reconsider and withdraw the rejection.

#### **VI. Rejection under 35 U.S.C. § 112, second paragraph**

Claims 42-48 were rejected for reciting that the broadcast is "selectively" a television broadcast. The claims have been amended to remove the questioned language. Applicant requests that the examiner reconsider and withdraw the rejection.

#### **VII. Rejection under 35 U.S.C. § 101**

Claims 42-48 were rejected under § 101 as not directed to statutory subject matter because they "are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter." Office action at ¶¶ 26, 27.

Applicant respectfully traverses this ground of rejection. Independent claims 42 and 46 require "connecting the website to computers of a plurality of users." This step specifies particular machines – users' computers – and it is moreover transformative. Connecting a website to a computer involves at least transferring data, with formatting typically specified by html encoding, to the computer. Thus, the result of the process step is a computer transformed by the acquisition of the data of the website. Claim 46 further requires the

transformative process step of "recording the responses of the plurality of users to the one or more questions on the website." Because the recording involves responses provided through the website, it necessarily involves producing an electronic tabulation of the recorded responses.

Because all of the claimed processes involve machines and, moreover, transform physical subject matter, they are directed to statutory subject matter under § 101. Reconsideration and withdrawal of the rejection are requested.

### **VIII. Rejections on Prior Art**

All of the pending claims were rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,818,441 (Throckmorton) in combination with Pitkow (1995). The rejection is respectfully traversed.

With this response, applicant submits a declaration under 37 C.F.R. § 1.131 submitted by the inventor, Shelton L. Palmer, in parent reissue application serial no. 09/860,259. This declaration, as explained below, demonstrates conception and reasonable diligence toward a reduction to practice of as much of the invention claimed in this application at Throckmorton discloses. "[U]nder the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference." *In re Stempel*, 241 F.2d 755, 759, 113 U.S.P.Q. 77, 81 (C.C.P.A. 1957). Accordingly, the declaration is effective under § 1.131 to negate the prior art effect of the Throckmorton reference as to the pending claims. Without the disclosure of that reference, the rejection cannot stand.

In the § 1.131 declaration, Mr. Palmer clearly explains how aspects of a specific article of evidence accounts for every limitation or feature of the claims in the '259 application, using the particular limitations of claim 17 of the '259 application as an illustrative example (Palmer dec. ¶ 15). Mr. Palmer also explains in clear terms the references to different terminology to facilitate understanding of this correspondence. As a result, the Palmer declaration clearly provides sufficient evidence of the complete conception of the subject matter common to the present claims and the Throckmorton reference.

The '111 provisional application, filed on 30 October 1995, establishes a constructive reduction to practice of the pending claims. Accordingly, the declaration sets forth evidence of reasonable diligence from a date prior to the effective date of the Throckmorton reference until the filing date of the '111 application. Specifically, from a time prior to 15 June 1995 through 30 October 1995, Mr. Palmer was continually engaged in range of activities, both related to prototyping, testing, development, commercialization, funding, and patenting of the presently claimed invention, as well as to other matters related to Mr. Palmer's substantial responsibilities as President and Creative Director of a successful audio/visual production company, SLP Productions.

The test for reasonable diligence under § 1.131 must take account of the personal circumstances of the inventor. Indeed, to determine whether the amount of activity devoted to the constructive or actual reduction to practice of the invention was "reasonable" or not requires an assessment of the capacity of the inventor to devote time to such inventive efforts. In this respect, it is important to appreciate that Mr. Palmer, as a composer and artist who also served as president and creative director of an active and successful media production company, had significant demands on his time during the critical period. Despite this, throughout this time period, he diligently worked to prototype, test, and evaluate various commercial embodiments of the invention, while also pursuing efforts to commercially develop the invention (including by attempting to secure funding and development partners), and to patent the invention.

Thus, to properly assess whether Mr. Palmer was reasonably diligent during the critical period, one must assess the effects of the tremendous demands on his time throughout the critical period. During this period, Mr. Palmer routinely devoted entire days to his business responsibilities at SLP Productions (e.g., composing music, writing scripts and crafting pitch material, and, critically, engaging in performance, directing and production of audio and audiovisual programs and content. (Palmer dec. ¶¶ 59-62). For example, during typical production days, Mr. Palmer would have to devote between 8 and 12 hours toward performance, direction, production, post-production processing and review of an audio or audiovisual performance. In a typical pre-production day, Mr. Palmer would devote 10 to 16 hours writing scripts, composing music and designing specific audio or audiovisual works that had been contracted for by clients. These substantial time commitments from

his role in SLP Productions meant that Mr. Palmer could only devote a limited amount of time toward other activities, including those related toward testing, commercial development, funding and patenting of the presently claimed invention.

To facilitate consideration of this evidence of diligence, applicant provides the following monthly summaries of events described in more detail in the Palmer declarations. This narrative illustrates the wide range and significant amount of activities that occupied Mr. Palmer time during the critical period of just prior to 15 June 1995 until 30 October 1995. Applicant observes that the presentation below identifies both the activities of Mr. Palmer that were directly related to the claimed invention, and those that pertain to other matters. However, as explained above, under the proper legal standard, both types of evidence are relevant to demonstrate that Mr. Palmer engaged in reasonable diligence toward the constructive reduction to practice of the invention.

**(i) Activities Up to 15 June 1995**

- Mr. Palmer developed a complete, documented conception of the Roboweb invention and mapped a strategy for commercializing it. (Palmer dec. ¶¶ 7-16, 19-25)
- Mr. Palmer built a "proof-of-concept" device for routing a URL from a broadcast source to a computer. (Palmer dec. ¶ 31)
- Mr. Palmer investigated both availability of patent protection for the invention and the availability of financing to produce commercial embodiments of the Roboweb system. (Palmer dec. ¶¶ 28-29)
- Mr. Palmer explored the potential utility of the Roboweb system for various applications. (Palmer dec. ¶¶ 33-34)
- Mr. Palmer foresaw that an actual reduction to practice of the Roboweb invention would be in a commercial setting. (Palmer dec. ¶ 35)
- Mr. Palmer investigated particular implementation mechanisms, including different hardware configurations and types of data networks, in pursuing the reduction to practice. (Palmer dec. ¶¶ 36-38)
- Before 15 June 1995, Mr. Palmer was also involved in producing a number of projects at SLP Productions, including the production of numerous demonstration works (demos), promotional works (promos) and other works for various entities. This included production works for television programs and networks (Tempest, Ricki Lake, Oprah

television show, Central Park West, KTVT production package, etc.), radio (Fred Goldberg Radio), and various advertising efforts (Seagram's Advertising, Banana Boat Suncare, R&R Advertising). (Palmer dec. ¶¶ 65-66)

- Mr. Palmer was also regularly occupied with administrative duties associated with being president and creative director of SLP Productions, Inc., a company with 30 full-time staff, 600 part-time editors, hundreds of part-time musicians and 80 part-time singers and voice-over artists. (Palmer dec. ¶¶ 59-62)

#### **(ii) Activities During June 1995**

- Mr. Palmer contacted Larry Morgan, of Premiere Radio Networks, to discuss implementing a Roboweb system over a national radio network. (Palmer dec. ¶ 37)

- Mr. Palmer investigated equipment that would be suitable for testing the use of the vertical blanking interval (VBI) to embed addresses, such as URLs, in video signals apart from the video content *per se*. (Palmer dec. ¶ 38)

- Mr. Palmer was developing high-level software schemas, as well as designing alternative configurations for implementing the Roboweb invention. (Palmer dec. ¶¶ 39-40)

- Mr. Palmer prototyped pager system software, which was operational, and continued to develop the Roboweb invention to the point where he foresaw potential for collaboration with Internet Service Providers to provide access to web pages without requiring users of Roboweb to be subscribers of the ISP. (Palmer dec. ¶ 40)

- Mr. Palmer further developed the Roboweb invention, renaming it "Pageweb" and developed specific embodiments of Roboweb that would display both video content and data on a single display. (Palmer dec. ¶ 41)

- Throughout June, Mr. Palmer continued his considerable creative and administrative duties at SLP Productions, including production of works for television (Tempest, Ricki Lake, Oprah, "Central Park West," etc.), radio (Fred Goldberg Radio), and advertising (Seagram's Advertising, Banana Boat Suncare). (Palmer dec. ¶¶ 65-66)

- Mr. Palmer was also involved in other professional activities that required his attention, including a presence at several conventions (National Ass'n of Television Programming Executives, PROMAX, and



a marketing executives conference) and obtaining new video room financing. (Palmer dec. ¶ 66)

**(iii) Activities During July 1995**

- Mr. Palmer was actively investigating functional elements, including commercially available hardware and software components, that would be used to implement and test a fully functional embodiment of the invention. (Palmer dec. ¶¶ 42-43, 46)
- Mr. Palmer developed a prototype of the Roboweb invention that was sufficient for demonstrating the essential software features of the invention, including a way of displaying text pager messages on a computer screen based upon user behavior responsive to television signals. (Palmer dec. ¶ 42)
- Mr. Palmer continued testing and developing different embodiments of the Roboweb invention as part of his efforts to reduce the invention to practice. (Palmer dec. ¶¶ 43-44)
- Mr. Palmer also investigated potential financing sources for the Roboweb project. (Palmer dec. ¶ 45).
- Throughout July, Mr. Palmer also continued his considerable creative and administrative duties with SLP Productions, Inc. For example, Mr. Palmer was engaged in the production of musical "theme concepts" for a television show to be broadcast in the coming fall season ("Central Park West") as well as broadcast advertising campaigns for a large retailer and television talk shows. He also arranged meetings with Ricki Lake senior production staff.

In addition, Mr. Palmer put together pitch materials for the launch of a cable news channel, CNN-FN. He was involved in meetings to pitch to various production companies, including Paramount TV, Kingworld TV, AME, Warner Brothers, Premiere Radio Network and others. (Palmer dec. ¶¶ 65-66)

- Mr. Palmer also co-founded the TV/Music Licensing Committee to deal with ASCAP practices regarding commercial music composers. (Palmer dec. ¶ 66)
- Mr. Palmer's father was also hospitalized during July 1995, further impacting his available time. (Palmer dec. ¶ 66)

**(iv) Activities During August 1995**

- Mr. Palmer initiated discussion with a Management Information Systems specialist to pursue implementation of television broadcast embodiments of the Roboweb invention. (Palmer dec. ¶ 48)

- Mr. Palmer continued developing alternative conceptual approaches to implementing the invention. (Palmer dec. ¶¶ 51)
- Mr. Palmer continued efforts to prototype hardware implementations of the invention, develop the invention and refine the demonstration of the Roboweb for potential investors. (Palmer dec. ¶¶ 50)
- Mr. Palmer began efforts directed toward the preparation and filing of a patent application, including preparing notes and specifications that could be used as the basis of a provisional patent application. (Palmer dec. ¶¶ 52)
- Mr. Palmer continued his investigation of different sources of financing for the commercialization of Roboweb. (Palmer dec. ¶¶ 53)
- Throughout August, Mr. Palmer also continued his considerable creative and administrative duties with SLP Productions, Inc. For example, he continued his advertising and television production activities, including producing works for Tempest talk show, Seagram's advertising campaign, a commercial and jingle program for the Oprah television show and advertising efforts for Hermann's Sports and Fred Goldberg Radio. (Palmer dec. ¶¶ 65-66)
- Mr. Palmer also began efforts in respect of a music and video presentation for the Service Merchandise Sales Conference held later that year. He was also engaged in distribution and pricing efforts with DJP Design Inc. (Palmer dec. ¶¶ 65-66)

**(v) Activities During September 1995**

- Mr. Palmer continued discussions with Premiere Networks at the level of its president, Kraig Kitchin, to discuss a commercial implementation of the invention.
- Mr. Palmer continued his efforts to procure strategic investment, or sale, of the Roboweb project, including through communications with Mr. Kitchin concerning sale or investment by Premiere Networks. (Palmer dec. ¶¶ 53-54)
- Mr. Palmer continued his efforts directed toward preparation and filing of a patent application. (Palmer dec. ¶¶ 52)
- Throughout September, Mr. Palmer continued his considerable creative and administrative duties with SLP Productions, Inc, including by producing works for the Tempest project, Seagram's advertising, Fred Goldberg Radio and other efforts. Mr. Palmer was also involved

in developing demonstration recordings for television news programs. (Palmer dec. ¶¶ 65-66)

- Mr. Palmer was also engaged in projects with a number of television stations, including WDSU-TV and KPDX-TV. He also performed work for the Omni Berkshire Hotel company. (Palmer dec. ¶ 66)

**(vi) Activities During October 1995**

- Mr. Palmer prepared a detailed explanation of the Roboweb invention and provided it to his patent attorney, Bruce Sales, for preparation of a patent application. (Palmer dec. ¶¶ 52, 55-56)

- Mr. Palmer continued talking to experts about possible implementations of the invention. (Palmer dec. ¶ 57)

- Mr. Palmer's patent attorneys prepared the specification that would be filed as the '111 provisional application. (Palmer dec. ¶¶ 6, 55-56)

- Mr. Palmer selected a trade name, "Web Pager," for the Roboweb invention and also discussed trademark protection for commercial uses of the invention with his attorneys. (Palmer dec. ¶¶ 56, 58)

- Throughout October, Mr. Palmer continued his considerable creative and administrative duties with SLP Productions, Inc, including by producing works for the Tempest project, Seagram's advertising, Service Merchandise and other efforts. (Palmer dec. ¶¶ 65-66)

- Mr. Palmer performed numerous administrative duties with SLP Productions, Inc, including quarterly financial review and addressing staffing matters. Mr. Palmer also continued his work with DJP Design. (Palmer dec. ¶¶ 66)

- The '111 application was filed on 30 October 1995. (Palmer dec. ¶ 6)

As the above summary demonstrates, Mr. Palmer was engaged in a significant volume of work related to his ongoing responsibilities as President and Creative Director of SLP Productions in addition to the significant efforts he devoted to testing, commercial development, obtaining funding and partners for, and patenting of the claimed invention.

In addition, as Mr. Palmer explains in more detail in his Declaration, throughout the critical period, it was Mr. Palmer's established practice to work on a particular aspect of a project up to the point that it required input from another source. No project, including

Roboweb, was ever put on a “back burner.” Instead, Mr. Palmer would resume his development activities as soon as he received the necessary input. Palmer dec. ¶ 23. As he explains, this was particularly true with respect to the Roboweb invention, which required, during the critical phase, feedback from research and testing activities, responses to requests for funding or collaboration for testing of the invention, and guidance from Mr. Palmer’s attorneys concerning patenting of the invention.

As Mr. Palmer explains in more detail in his Declaration, Exhibits G-I of the declaration establish, with corroborative evidence, continued efforts toward both an actual and constructive reduction to practice. Moreover, the diligence of others contributing to a reduction to practice at the inventor’s behest – notably the work of his patent attorneys – is properly credited as diligence by the inventor. See M.P.E.P. § 2138.06. Collectively, these exhibits demonstrate a continuum of work by the inventor throughout the entirety of the relevant period to both actually and constructively reduce the invention to practice.

Assessed under the proper legal standard, the evidence provided in the Palmer declarations establishes that applicant has antedated the Throckmorton reference according to the requirements of the law and Office practice. Accordingly, the prior art rejections that rely on Throckmorton should be withdrawn.

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### CONCLUSION

For at least the reasons set forth above, applicant requests that the Office reconsider and withdraw all of the outstanding objections to and rejections of the claims in this application, and indicate that all of the pending claims are allowable.

The examiner is invited to contact applicant's undersigned representative at the phone number below or Jeffrey Kushan at (202) 736-8914 should he have any questions or concerns.

Respectfully submitted,

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